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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/604,017 | 06/21/2003 | Ronald Sherry | 71-001 | 1016 |

31989 7590 08/03/2004

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EXAMINER

O CONNOR, CARY E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/604,017 | Applicant(s) SHERRY ET AL <i>CM</i> | |
| | Examiner Cary E. O'Connor | Art Unit 3732 | |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>062103</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the transverse member inferior border" in line 13.

There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "the transverse member inferior border" in line 19.

There is insufficient antecedent basis for this limitation in the claim.

Claim 26 is an improper dependent claim because claim 24 is not drawn to a method of producing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4, 7-13, 18-21, 23, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Milano (2,831,840). Milano shows a shield comprising a handle 10 having a first end for gripping and a second end. A first shield 14 has an anterior end

transitioning from the handle second end and has a posterior end and an inferior border. A non-hinging transverse member 15 has a first end transitioning from the first shield posterior end, a second end and an inferior border. A second shield 18 has an anterior end, a posterior end and an inferior border. The transverse member inferior border does not extend as far inferiorly as the first and second shield inferior border (see Figures 3 and 4). As to claim 2, note that the shield may be made of stainless steel (column 2, lines 41-42) which inherently be sterilized. As to claim 4, note that the parts of the shield are of a unitary construction (column 2, line 36). As to claim 7, since the handle is meant for gripping, it inherently has a cross section of a geometric shape that will permit effective gripping. As to claim 8, note that the handle comprises an anterior grip and a shaft 11 which transitions into the first shield anterior end. As to claims 9 and 10, the first and second shields are "substantially" planar and oriented in a "substantially" vertical dimension. The second shield is slightly cupped (see Figure 1). As to claim 11, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As to claim 13, the handle superior border transitions into the first shield superior border and the handle inferior border transitions into the first shield superior border through the use of a radius of effective inclination and curvature to

prevent sharp corners (see Figure 2). As to claims 18 and 21, note that the transverse member inferior border transitions into the first and second shield inferior borders through the use of a radius to prevent creation of sharp corners. As to claims 19 and 21, the handle transitions the handle transitions into the first shield anterior end at a location between the first shield inferior and superior borders through the use of a radius to prevent sharp corners. As to claims 20 and 21, the transverse member second end transitions into the second shield posterior end at a location between the second shield inferior and superior borders through the use of a radius to prevent sharp corners. As to claim 23, note that the second shield anterior end is rounded. As to claim 24, note Figure 4.

Claims 1, 7, 9-16, 18-21, 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hachman (1,498,267). Hachman shows a shield comprising a handle 13 having a first end for gripping and a second end. A first shield 17 has an anterior end transitioning from the handle second end and has a posterior end and an inferior border. A non-hinging transverse member 15 has a first end transitioning from the first shield posterior end, a second end and an inferior border. A second shield 18 has an anterior end, a posterior end and an inferior border. The transverse member inferior border does not extend as far inferiorly as the first and second shield inferior border. As to claim 7, since the handle is meant for gripping, it inherently has a cross section of a geometric shape that will permit effective gripping. As to claims 9 and 10, the first and second shields are "substantially" planar and oriented in a "substantially" vertical dimension. The second shield is slightly cupped (see Figure 2). As to claim 11, a recitation of the

intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). As to claim 13, the handle superior border transitions into the first shield superior border and the handle inferior border transitions into the first shield superior border through the use of a radius of effective inclination and curvature to prevent sharp corners (see Figure 2). As to claims 14-16, note that the handle is set at an angle of about 45 degrees to the first shield (see Fig. 1). As to claims 18 and 21, note that the transverse member inferior border transitions into the first and second shield inferior borders through the use of a radius to prevent creation of sharp corners. As to claims 19 and 21, the handle transitions the handle transitions into the first shield anterior end at a location between the first shield inferior and superior borders through the use of a radius to prevent sharp corners. As to claims 20 and 21, the transverse member second end transitions into the second shield posterior end at a location between the second shield inferior and superior borders through the use of a radius to prevent sharp corners. As to claim 23, note that the second shield anterior end is rounded. As to claim 24, note Figure 1. As to claim 25, note that a moisture barrier is secured with the shield (page 1, lines 59-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milano (2,831,480) in view of Riewenherm (5,490,780). Milano does not teach that the shield has a highly polished surface to provide a reflective surfaced. Riewenherm shows a shield having a highly polished reflective surface (column 6, lines 43-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the shield of Milano with a highly polished reflective surface, in view of Riewenherm, so that the dentist may view the area without the use of a separate instrument.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milano (2,831,480) in view of Caswell (965,079). The shield of Milano is not formed by fastening the handle to the first shield anterior end. Caswell shows a dental shield wherein the handle is fastened to the first shield 2 anterior end by means of a screw connection. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the shield of Milano as taught by Caswell, so that the orientation of the handle relative to the shields may be adjusted.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hachman (1,498,267). Without a showing of criticality, the specific angle that the

handle is oriented is considered to have been an obvious design choice, to one of ordinary skill in the art.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milano (2,831,480) in view of Hertz (5,813,857). The shield of Milano does not include an access opening in one of the first and second shields. Hertz shows a shield device having an access opening 30 so that a saliva ejector may be introduced therethrough. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide one of the first and second shields of Milano with an access opening, in view of Hertz, so that a saliva ejector could be placed and held in the mouth by the shield.

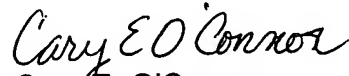
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-F 7:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
August 1, 2004